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In re Application of MARTINEZ et al
U.S. Application No.: 10/550,608
PCT Application No.: PCT/EP04/03219
Int. Filing Date: 25 March 2004
Priority Date Claimed: 26 March 2003
Attorney Docket No.: ABG 3008
For: IN VITRO METHOD TO DETECT
BLADDER TRANSITIONAL CELL
CARCINOMA

DECISION

This is in response to applicant's "Renewed Petition Under 37 C.F.R. §1.47(a)" filed 28 August 2006.

BACKGROUND

On 25 March 2004, applicant filed international application PCT/EP04/03219, which claimed priority of an earlier Spain application filed 26 March 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 07 October 2004. The thirty-month period for paying the basic national fee in the United States expired on 26 September 2005.

On 26 September 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 19 April 2006, applicant filed a petition under 37 CFR 1.47(a).

On 27 June 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 14 July 2006, this Office mailed a decision dismissing the 19 April 2006 petition.

On 28 August 2006, applicant filed the present renewed petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Miguel Molina Vila refuses to sign the application papers. The renewed petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to Miguel Molina Vila for signature via electronic mail on 09 March 2006 (see affidavit of Andreas Baltatzis and English translation of the 09 March 2006 electronic mail message). The inventor's failure to respond to the 09 March 2006 communication and to repeated other communications sufficiently illustrates his refusal to cooperate. Thus, it can be concluded with reasonable certainty that Miguel Molina Vila refuses to join in the application.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 25 March 2004, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 19 April 2006.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



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